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09/927,628	08/10/2001	Andrew H. Pritchard	00-1024	5363

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EXAMINER	
AKINTOLA, OLABODE	

ART UNIT	PAPER NUMBER
3691	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/927,628	PRITCHARD, ANDREW H.	
	Examiner	Art Unit	
	OLABODE AKINTOLA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-7,17-21,23-29,31 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-7,17-21,23-29,31 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 20-21, 23-29 and 32 are objected to under 37 CFR 1.75(c) as being in improper form. See MPEP § 608.01(n).

Applicant is request the recite all the method steps in the apparatus claims from their corresponding method claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-7, 17-21, 23-29, 31 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 20 recite the limitation "the investment instrument" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claims 1 and 20 recite the limitation "the computing device" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claims 2, 4-7, 17-19, 21, 23-29, 31 and 33 are similarly rejected by dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 4-7, 17-21, 23-29, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman (US 6601044) (Wallman) in view of Altomare et al (US 7249075) (Altomare), in view of Wilkinson (US 20010034695) (Wilkinson) and further in view of Tull, Jr. et al (US 5946667) (Tull).

Re claims 1 and 20: Wallman teaches a method comprising: receiving from a remote computer device at least one risk/return preference that is provided by a user (abstract, col. 14, lines 29-48); selecting, based on the at least one risk/return preference, a plurality of instruments (abstract, col. 14, lines 29-48); storing at the computing device the selected plurality of instruments in an investment trust that is traded on an exchange, in which the remote device and the computing device are in communication via a network (col. 15, lines 38-45); tracking via a

computing device a performance of the investment instrument and a performance of each of the selected plurality of instruments on the exchange (col. 16, line 65 through col. 17, line 17); storing at the computing device the performances in a database (col. 16, line 65 through col. 17, line 17).

Wallman does not explicitly teach that the plurality of instruments comprises of a first financial instrument of a first type that comprises an intellectual property right; a second financial instrument of a second type, in which the second type differs from the first type; and determining by the computing device, based on the performances, to trade at least one share of the investment trust; and transmitting via the computing device a request to trade the share of the investment trust.

Altomare teaches the concept of selecting a plurality of instruments comprising at least one of first financial instrument of a first type (***equity instrument***) and a second financial instrument of a second type, in which the second type differs from the first type (***at least one fixed return instrument***); storing said plurality of instruments in an investment trust that is traded on an exchange (col. 24, lines 43-47). Altomare does not teach that the equity instrument comprises an intellectual property right. However, Wilkinson teaches that an ***equity instrument as an intellectual property right*** (paragraphs 0005-0008). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include these features as taught by the teachings of Altomare and Wilkinson. One would have been motivated to do so in order to enhance the flexibility of the process/system by diversifying the user's portfolio to include various types of instrument.

Tull teaches the concept of storing plurality of instruments in an investment trust; determining by a computing device, based on performances, to trade at least one share of the investment trust; and transmitting via a computing device a request to trade the share of the investment trust (col. 6, lines 14-24, col. 7, lines 50-67, col. 15, lines 15-33, col. 17, lines 25-45).
It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include these features as taught by Tull. One would have been motivated to do so in order to rebalance the investor's portfolio (or trust) as determined by the performances.

Re claims 2 and 21: Wallman does not explicitly teach determining, based on a performance of at least one of the plurality of instruments, to trade at least one instrument; and transmitting by a computer processor a request to trade the least one instrument on the exchange. Tull teaches determining, based on a performance of at least one of the plurality of instruments, to trade at least one instrument; and transmitting by a computer processor a request to trade the least one instrument on the exchange (col. 7, lines 50-67, col. 15, lines 15-33, col. 17, lines 25-45).
It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include these features as taught by Tull. One would have been motivated to do so in order to rebalance the investor's portfolio (or trust) as determined by the performances.

Re claim 4 and 23: Wallman teaches wherein the act of tracking the performance of each of the selected plurality of instruments further comprises: monitoring a value of each selected instrument over a period of time. Wallman does not explicitly teach monitoring a value of each selected instrument in real time. Tull teaches monitoring a value of each selected instrument in

real time (col. 2, line 67 through col. 3, line 1, and lines 22-25; col. 15, lines 55-62, col. 17, lines 41-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include real time monitoring of each selected instrument so that investors are aware of the current value of the selected instrument.

Re claims 5-6 and 24-25: Wallman does not explicitly teach the act of tracking the performance of the investment trust comprises: computing, based on the determined value of each selected instrument, an aggregate value of the investment trust; and adjusting the aggregate value by an external factor, wherein the external factor comprises at least one of: a management cost,; income accrued from each of the selected plurality of instrument; a fee associated with a custody; and a fee associated with clearing cost . Tull teaches the act of tracking the performance of the investment trust comprises: computing, based on the determined value of each selected instrument, an aggregate value of the investment trust; and adjusting the aggregate value by an external factor, wherein the external factor comprises at least one of: a management cost,; income accrued from each of the selected plurality of instrument; a fee associated with a custody; and a fee associated with clearing cost (col. 4, lines 37-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include these features as taught by Tull for the obvious reason of determining the aggregate and adjusted values of the portfolio.

Re claims 7 and 26: Wallman does not explicitly teach determining that at least one instrument of the investment trust has expired, in which the at least one of the instrument comprises a type;

and replacing the expired instrument with a new instrument, in which the new instrument shares the same type with the at least one instrument. Tull teaches: determining that at least one instrument of the investment trust has expired, in which the at least one of the instrument comprises a type; and replacing the expired instrument with a new instrument, in which the new instrument shares the same type with the at least one instrument (col. 4, lines 16-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include these features as taught by Tull for the obvious reason of rolling over to a new instrument within the same type.

Re claims 17 and 27 : Wallman teaches the second type of the second financial instrument comprises at least one of: a stock, a bond, a debt instrument, an exchange traded-fund, a mutual fund, a currency, a commodity, an equity investment, a futures investment, a futures contract, a dividend-paying investment, an intellectual property right, a real property and personal property (col. 19, lines 30-40).

Re claims 18 and 28: Wallman teaches wherein the risk/return preference comprises at least one of: a growth in equity that is selected by the user, a rate of return that is selected by the user, and a level of risk that is selected by the user (col. 14, lines 29-48).

Re claims 19 and 29: Wallman does not explicitly teach receiving a request to redeem the investment trust; calculating a value of the investment trust and converting the investment trust into the value in cash. Tull teaches receiving a request to redeem the investment trust; calculating

a value of the investment trust and converting the investment trust into the value in cash (col. 4, lines 16-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include these features as taught by Tull for the obvious reason redeeming the investment trust.

Re claims 31 and 33: Wallman does not explicitly teach that the first type of the first financial instrument comprises at least one of: a right to receive royalties on a copyright; and a right to receive royalties on a patent. Altomare and Wilkinson combination teaches these features (see claim 1 analysis above). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wallman to include these features as taught by the teachings of Altomare and Wilkinson. One would have been motivated to do so in order to enhance the flexibility of the process/system by diversifying the user's portfolio to include various types of instrument.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/

Examiner, Art Unit 3691